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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,289	04/13/2005	Renato Mariotti	163-568	3713
47888	7590	10/09/2007		
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER KHAN, AMINA S	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 10/09/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/509,289

Applicant(s)

MARIOTTI ET AL.

Examiner

Amina Khan

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 14 is/are rejected.
- 7) ☒ Claim(s) 9-13 and 15-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

### ***Information Disclosure Statement***

2. The information disclosure statement filed September 23, 2007 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Objections***

3. Claims 9-13 and 15-19 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim because claim 9 is a multiple dependent claim

Art Unit: 1751

depending from claim 7, another multiple dependent claim and claim 15 is a multiple dependent claim depending from claim 7 or 9 which are also multiply dependent. See MPEP § 608.01(n). Claims 10-13 and 16-19 depend from the improper multiply dependent claims and therefore are also objected to. Accordingly, the claims 9-13 and 15-19 have not been further treated on the merits.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1,2,6 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Sammis (US 6,143,115).

Sammis teaches a paper sheet treated with a release agent, a printed image and a uniform layer of a thermoplastic material disposed over the printed image, wherein a plurality of abrasive particles is imbedded within the transfer layer (abstract). Sammis

further teaches that the adhesive-abrasive articles are ground polyester and are applied to the transfer material and sintered by heating, whereby the particles are partially melted and securely adhered to the transfer material and will not detach from it (column 4, lines 25-45).

Accordingly, the teachings of Sammis are sufficient to anticipate the material limitations of the instant claims.

7. Claims 1,2,4,7 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mahn, Jr. (US 5,364,688)

Mahn, Jr. teaches an indicia bearing transfer which can be applied to elastomeric articles (column 1, lines 40-45) Mahn, Jr. further teaches printing a sublimation dye onto a transfer sheet and laminating on the remaining portions of the transfer (column 3, lines 50-55). Mahn, Jr. further teaches an elastomeric layer (Figure under abstract, #16) which is a procured polyester thermoplastic elastomer with a melting point of 250-400°F (column 2, lines 24-45). Mahn, Jr. further teaches applying a thermoplastic elastomer layer having a film thickness of 2 to 20 mils (column 4, lines 25-40).

Accordingly, the teachings of Mahn, Jr. are sufficient to anticipate the material limitations of the instant claims.

In the alternative, if the teachings of Mahn, Jr. are not sufficient to anticipate the material limitations of the instant claims, it would have nonetheless been obvious to one of ordinary skill in the art at the time the invention was made to select polyester for the elastomeric layer with the instantly claimed melting point because Mahn, Jr. teach the utility of laminating these thermoplastic polymers onto a transfer sheet for the benefit of

Art Unit: 1751

marking a elastomeric substrate or article. One of ordinary skill in the art at the time the invention was made would have been motivated to select the instantly claimed elements from the teachings of Mahn, Jr. absent unexpected results.

8. Claims 1,2 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative under 35 U.S.C. 103(a) as obvious over Donenfeld (US 4,576,610)

Donenfeld teaches transfer papers comprising a transfer paper coated with a dye followed by a release layer and a polyester resin (column 8, lines 1-25)

Accordingly, the teachings of Donenfeld are sufficient to anticipate the material limitations of the instant claims.

In the alternative, if the teachings of Donenfeld are not sufficient to anticipate the material limitations of the instant claims, it would have nonetheless been obvious to one of ordinary skill in the art at the time the invention was made to select the order of layers because Mahn, Jr. teach the utility of providing a transfer element with layers of this order for the benefit of improved sublimation transfer printing which is fast through repeated laundering. One of ordinary skill in the art at the time the invention was made would have been motivated to select the instantly claimed elements from the teachings of Donenfeld absent unexpected results.

9. Claims 1,2,5 and 14 are rejected under 35 U.S.C. 103(a) as obvious over Suzuki et al. (US 6,737,152)

Suzuki et al. teach a substrate sheet with a dye-colored image and a protective layer, which covers part of the print (column 3, lines 20-30). The protective layer is composed of polyester resin laminate (column 4, lines 5-15). Suzuki et al. further teach applying a release layer by the conventional methods of gravure coating (column 6, lines 55-60).

Suzuki et al. do not teach all the instantly claimed embodiments in a single example and are silent as to the methods of coating the polyester.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the instantly claimed components because Suzuki et al. teach the utility of providing a transfer element with a protective layer for the benefit of improved printing which is weather and fade resistant. Furthermore, it would have been obvious to coat the polyester resin by the gravure methods taught for the release layer because these methods are conventional coating methods as taught by Suzuki et al. One of ordinary skill in the art at the time the invention was made would have been motivated to select the instantly claimed elements from the teachings of Suzuki et al. absent unexpected results.

10. Claims 1-3,5 and 14 are rejected under 35 U.S.C. 103(a) as obvious over Takeyama et al. (US 5,322,832)

Takeyama et al. teach image-receiving sheet for a thermal transfer recording medium comprising a interlayer of a polyester resin which is coated by forming bubbles in the extrusion (column 7, lines 60-68; column 8, lines 5-35). Takeyama et al. further

teach the functional equivalence of conventional methods of gravure coating, roller coating and extrusion coating (column 9, lines 40-45).

Takeyama et al. do not teach all the instantly claimed embodiments in a single example.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the instantly claimed components because Takeyama et al. teach the utility of providing a image-receiving sheet with a interlayer layer of polyester for the benefit of improved cushioning properties. Furthermore, it would have been obvious to coat the polyester resin by the gravure or roller methods taught for the image-receiving layer because these methods are conventional and functionally equivalent coating methods to extrusion as taught by Takeyama et al. One of ordinary skill in the art at the time the invention was made would have been motivated to select the instantly claimed elements from the teachings of Takeyama et al. absent unexpected results.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amina Khan whose telephone number is (571) 272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone

Art Unit: 1751

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*AK*

AK  
September 29, 2007

*Lorna M. Douyon*  
LORNA M. DOUYON  
PRIMARY EXAMINER